REMARKS

Claims 1, 2, 5-10, 12, and 14-33 are currently pending. Claims 1, 12, 15, 16, 20, 23, 24, 25, 29 and 31 have been amended. Claims 3-4, 11 and 13 were cancelled in a previous amendment.

1.   Response to Claim Objections

The status of claim 1 is "Currently Amended" and the status of claim 26 is now "Previously Presented."

2.   Response to Claim Rejections Under 35 USC § 103(a)

Claims 1-2, 5-10 and 23-33 are rejected under 35 USC § 103(a) as being unpatentable over Wilson (US 6,460,031) in view of Gobburu (US 6,736,322). The Examiner has argued that Wilson discloses a system for generating a query interface to a database. The Examiner also states that Gobburu teaches receiving user profile information associated with a user formulating the queries and suggests that it would have been obvious to formulate queries based on user profile information. (Office Action, Page 3.)

The pending application was filed on December 6, 2001 and claims priority to provisional application no. 60/286,259 which was filed on April 24, 2001 and provisional application no. 60/254,298 which was filed on December 8, 2000. Application No. 60/286,259 discloses the limitation of receiving user profile information associated with the user formulated the queries at page 15. Provisional Application No. 60/286,259 was filed before the filing date of Gobburu, November 19, 2001. The applicant respectfully submits that Gobburu may not be prior art depending upon the contents of Provisional Application No. 60/313,753 filed August 20, 2001, Provisional Application No. 60/252,101 which was filed on November 21, 2000 and Provisional Application No. 60/252,346 which was filed on November 20, 2000. More specifically, if the user profile disclosure that is the basis of the rejection is in Provisional Application No.

60/313,753 or only in the Application No. 09/996,847, Gobburu would not be prior art. Because these references are not available on the USPTO public PAIR system the applicant cannot determine if Gobburu is prior art. The applicant respectfully requests that Provisional Application Nos. 60/313,753, 60/252,101 and 60/252,346 be made available to determine if Gobburu is prior art.

The applicant has amended all claims to more clearly describe the invention and distinguish the claims from the teachings of Gobburu. Specifically, the claims have been amended to add the limitations that the receiving of the first selection from the first menu list and the second selection from the second menu list are from the user. The claims as examined did not specified the source of the menu selections. In contrast to user selections, Gobburu discloses a profile and schedule matching function that is a computer program that automatically generates queries to a database based on the user profile. The queries are therefore computer generated and independent from the user's data input through a menu selection. The applicant submits that there is a substantial difference between a profile and schedule matching function that generates complete queries disclosed by Gobburu and the claim limitation of obtaining a second menu list based on the user profile information. The profile and schedule matching function is uses the profile information to generate queries, but it is not coupled to a user display or a user input device. More specifically, the user of the system does not receive any data processed by the profile and schedule matching function. Thus, the profile and schedule matching function does not generate any information used to produce a menu of user options.

There is no additional information about the profile and schedule matching function, however there is some additional descriptions of the mobile advertising and coupons application which the profile and schedule matching function is a sub-component. (Gobburu, Fig. 21.) The entire description of the mobile advertising and coupons application is reproduced below.

> Mobile advertising and coupons application 2140 performs a number of functions useful in ticketing and coupon transactions. Report and analysis tools 2144 generates various reports for stores, clearinghouses, manufacturers, and the user. Administration and advertisement pricing module 2142 and a coupon redemption and validation module 2146 provide standard functions relating to reporting coupon usage data to clearinghouses. A

profile and schedule matching function 2148 generates queries to the My Transactions
database based on user profile and user schedule information. The inventory and
campaign management function 2150 generates various queries to external databases.
For example, the user may request coupons for a desired product, or such requests may be
generated automatically from time to time so that coupons may be obtained from vendors
which have not registered with and which therefore do not push coupon information to
the user's My Transactions database.

(Gobburu, Col. 22, lines 41-59, Fig. 21, emphasis added.)

Based upon this disclosure, the mobile advertising and coupons application provides

ticketing and coupon transactions and is able to request coupons for products. Within the

description, there is also a statement that the user may reqeust coupons or the system can

automatically generate the coupon requests. The applicants interpret this statement as meaning

that the user of the system can request coupons or alternatively the system can automatically

produce coupon request queries without any user interaction. Based upon the description of the

the mobile advertising and coupons application in Gobburu, the applicant submits that the

queries from the profile and schedule matching function are part of an automated system for

depositing advertisement coupons into the user's transaction database that is an alternative to

manual coupon requests. Thus, there is no disclosure or explicit suggestion of using the user

profile to produce a menu of options for data input selection by a user. For these reasons, the

applicant submits that Gobburu does not disclose or suggest the claim limitation of providing

menu options for the user based upon the user's profile.

The applicant also submits that it is improper to combine the data input system

disclosed by Wilson with the profile and schedule matching function of Gobburu. The applicant

respectfully disagrees with the Examiners statement that the motivation to combine the

references would have been to provide more relevant results to users. The requisite motivating

suggestion must be explicit. *Winner International Royalty Corp. v. Wang*, 48 USPQ.2d 1139

(D.C. 1998) ("...there must have been some explicit teaching or suggestion in the art to motivate

one of even ordinary skill to combine such elements so as to create the same invention."). The

Examiner must also identify where the prior art provides a motivating suggestion for the

combination. *In re Jones*, 958 F.2d 347, 21 USPQ.2d 1941 (Fed. Cir. 1992).

In the Office Action, the Examiner argued that the motivation for formulating queries based on the user profile information would have been "to provide more relevant results to users." (Office Action, page 3.) The applicant respectfully argues that the Examiner's specified motivation does not meet the requirement of "explicit teaching or suggestion in the art to motivate one of even ordinary skill to combine such elements." The applicant also submits that neither Wilson nor Gobburu provide an explicit or implied motivation for combination because there would not be any benefit to combining the specified disclosures of the references. Gobburu discloses a profile and schedule matching function produces queries based upon the user profile but does not utilize any user input or interaction to produce the queries. Because the profile and schedule matching function is an independent process that does not interact with a data input system, there is no need or suggestion for combining with the data input system disclosed by Wilson. The combination of the automated coupon request system of Gobburu and the menu input system of Wilson would be two independent systems that would allow user queries or alternatively automated queries. There is no teaching or suggestion of using the user profile to produce menu lists.

For the reasons discussed above, the applicant submits that claim 1 is not unpatentable over Wilson in view of Gobburu. Claims 2 and 5-10 depend from claim 1 and are not unpatentable over Wilson in view of Gobburu for the same reasons discussed with regards to claim 1.

Independent claims 23 was amended to add the limitations that the constructing a natural language query is from a first user selection from a first series of user word or phrase menu selection and a second user selection is from a second series of user word or phrase menu selection, wherein the first and the second series of user word or phrase menu selections are based upon a user profile associated with the user. Again, the applicant submits that Gobburu does not disclose or suggest the limitations of menu selections based upon a user profile associated with the user. For the same reasons discussed above with respect to claim 1, claim 23 is not unpatentable over Wilson in view of Gobburu.

Claim 24 was amended to add the limitations that the receiving steps of words or phrases of the initial menu are from the user to specify that the words or phrases are selected by the user. The clams were also amended to add the limitation that the subsequent menu of words

or phrases is based upon a profile of the user. For the same reasons discussed above with respect to claim 1, the applicant submits that claim 24 is not unpatentable over Wilson in view of Gobburu because Gobburu does not disclose or suggest the limitations of a menu of words and phrases that is based upon a user profile. Claim 25 depends from claim 24 and is similarly not unpatentable over Wilson in view of Gobburu.

Claim 29 was amended to add limitation that the first selection is from a user to distinguish selections from any other source. Claim 29 also includes the limitation of obtaining a second menu list of words or phrases based on the first selection of at least one of the words or phrases in the first menu list and the user profile information. The applicant submits that Gobburu does not disclose or suggest a menu of words and phrases based upon the user profile associated with the user. The applicant submits that claim 29 is not unpatentable over Wilson in view of Gobburu. Claims 30-33 depends from claim 29 and are not unpatentable over Wilson in view of Gobburu for these same reasons.

Claims 12 and 14-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilson, in view of Gobburu and further in view of DeLorme (US 5,948,040). Claim 12 was amended to add the limitations: selecting a first word or phrase by the user, receiving a second series of user word or phrase menu selections biased with respect to a user profile associated with the user of the mobile computing device, selecting a second word or phrase by the user of the mobile computing device and constructing one or more phrases, sentences or questions from the first word or phrase and the second word or phrase. As discussed above with respect to claim 1, Gobburu does not disclose or suggest a menu of words and phrases based upon the user profile associated with the user. Thus, the applicant submits that Gobburu also does not disclose or suggest a menu of words and phrases that is biased with respect to the user profile and claim 12 is not unpatentable over Wilson in view of Gobburu and DeLorme. Claims 14-22 depend from claim 12 and are not unpatentable over Wilson in view of Gobburu and DeLorme for the same reasons discussed with respect to claim 12.

Applicant respectfully requests that the above described amendments be made part of the official record in the present application, and respectfully submit that support for the claim

Appl. No. 10/006,930
Amdt. Dated May 24, 2006
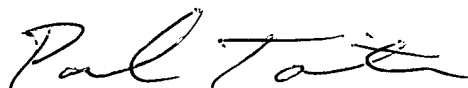Reply to Office Action of Sept. 23, 2005

amendments is present in the specification, claims, and drawings as originally filed, and that no

new matter has been added.

If there are any shortages, the Examiner is authorized to charge our Deposit Account

Number 04-0822.

Respectfully submitted,
DERGOSITS & NOAH LLP

Dated: May 25, 2006   By: Paul Tomita
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                                              Reg. No.: 43,193